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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,349

04/12/2004

Gary D. Rondeau

ASC 301

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7590

12/19/2005

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/823,349

Applicant(s)

RONDEAU ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the amendment filed on August 4, 2005. It is noted that in the amendment, applicant has amended claims 1 and 7.

### ***Drawings***

2. The objection to figure 1 as set forth in the Office action of 2/1/05, element 2, page 2) is repeated. In other words, Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See present specification in pages 1-2. See MPEP § 608.02(g).

***It is noted that in the amendment of 8/4/05, applicant has not amended or provided any explanation to overcome the objection to the figure 1.***

3. The objection to the drawings as set forth in the Office action of 2/1/05, element 3, pages 2-3) is repeated. In other words, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: The reference "33" as shown in each of figs. 2-3, and the reference "46" as shown in each of figs. 5-7.

***It is noted that in the amendment of 8/4/05, applicant has not amended or provided any explanation to overcome the objection to the drawings.***

### ***Specification***

4. The objection to the disclosure as set forth in the Office action of 2/1/05, element 5, pages 3-4, is repeated. In other words, the disclosure is objected to because of the

following informalities: The specification is objected to because it does not contain a Summary of the Invention. Appropriate correction is required.

***It is noted that in the amendment of 8/4/05, applicant has not amended or provided any explanation to overcome the objection to the specification.***

### ***Claim Objections***

5. The objection to the claims 1, 4-5 and 7 as set forth in the Office action of 2/1/05, element 6, pages 4-5, is repeated. In other words, claims 1, 4-5 and 7 are objected to because of the following informalities. Appropriate correction is required.

a) In claim 1: on line 6, the feature thereof "the XY plate assembly" lacks a proper antecedent basis. Applicant should note that the claim recites an X-axis plate and a Y-axis plate (see lines 3-4 of the claim). Should --defined by said X-axis plate and Y-axis plate-- after "the XY plate assembly" to make the feature claimed comply with the requirement of 35 USC 112?

b) In claim 4: on line 1, the feature thereof "the piezoelectric actuators" lacks a proper antecedent basis. Applicant should note that the base claim discloses a piezoelectric actuator mechanism having three spaced-apart portions (see claim 2). Should "actuators" (claim 4, line 1) be changed to --actuator mechanism-- to make the feature claimed comply with the requirement of 35 USC 112?

c) In claim 5: on line 2, the feature thereof "the three spaced-apart piezoelectric actuators" lacks a proper antecedent basis. Applicant should note that the base claim discloses a piezoelectric actuator mechanism having three spaced-apart portions (see claim 2). Should "actuators" (claim 5, line 2) be changed to

--actuator mechanism-- to make the feature claimed comply with the requirement of 35 USC 112?

d) In claim 7: on line 2, the following terms --the steps of-- should be inserted after "comprising".

***It is noted that in the amendment of 8/4/05, applicant has not amended or provided any explanation to overcome the objection to the claims 1, 4-5 and 7.***

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

a) The device as claimed in the amended claims 1 and 7 is rejected under 35 USC 112, first paragraph because the disclosure, as originally filed, does not provide support for the feature that the openings in each of the X-, Y-, and Z-axis plate is configured to allow passage of transmitted light. Applicant is respectfully invited to review the specification, in particular, in page 4, lines 14-18, which discloses that the openings of the plates are for the purpose of viewing the sample.

b) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 3, and 6-9, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Shirai et al (U.S. Patent No. 6,229,607).

Shirai et al disclose a mechanism for supporting an object or part to be measured wherein the object/part is observed by an objective lens of an optical microscope. See columns 4-5 and 7 (lines 21-24). It is noted that while each of the claims 1 and 7 recites a sample; however, each of the claims does not provide any specific feature/limitation for the so-called "sample to be investigated". The object/part to be measured as disclosed by Shirai et al is illuminated by an illuminating system and then detected by a detecting system. See columns 9-10 and fig. 7. In that aspect, the object/part provided by Shirai et al meets the feature of the so-called "sample to be investigated" recited in each of present claims 1 and 7. The mechanism as described in columns 6-7 and shown in figures 1-3 comprises a frame (11) having an internal opening (11a) which frame supports a X-axis mechanism of a platelike shape (12) for rectilinear shifting in a X-axis direction; a T-axis mechanism (13) having a plate with a circular opening (132a) for rectilinear shifting in a Y-axis direction; and a Z-axis mechanism (14) placed under the XY system and comprises a cylindrical moving section (141). A

piezoelectric actuator (142) is used to connect the z-axis moving section (141) to the XY system so that the actuator moves the Z-axis moving section along a Z-axis direction. The openings defined in each of the X-, Y-, and Z-axis element will inherently provide a means for allowing any light passing through and the object/part to be measured is viewed by the objective lens of the microscope. The operation of the piezoelectric actuator will permit the user of the system to adjust the distance between the object/part and the objective lens for the purpose of focusing. Regarding to the method as recited in claims 7-9, the steps as recited in the method claimed are readable in the structure of the microscope provided by Shirai et al. In other words, one skilled in the art will follow the step of providing a X-axis plate movable in a X-axis direction, providing a Y-axis plate movable in a Y-axis direction and forming a Z-axis element to a XY system via a piezoelectric element in the system of Shirai et al, and the step of installing a part to be measured on the Z-axis element and then observing the operation of the part to be measured by activating the illuminating and detecting system.

### ***Response to Arguments***

10. The amendments by adding new materials to claims 1 and 7, and applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

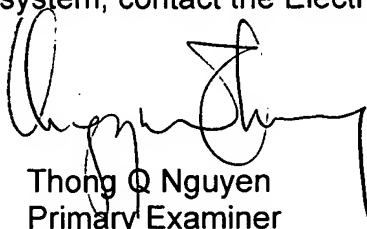
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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